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No. 10-426

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IN THE

Supreme Court of the United States

APPLERA CORP., ET AL.,

Petitioners,

v.

ENZO BIOCHEM, INC., ET AL.

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF AMICI CURIAE ALTERA CORPORATION; CISCO SYSTEMS, INC.; THE COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION (CCIA); GENERAL MOTORS, LLC; GOOGLE INC.; GUIDEWIRE SOFTWARE; INTUIT INC.; MICROSOFT CORPORATION; SAP AMERICA, INC.; AND SHORETEL IN SUPPORT OF PETITIONERS

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U.S. Const., art. I, § 8, cl. 8. 1

INTEREST OF *AMICI CURIAE*[1]

Amici are among the most innovative corporations in the world. *Amici* collectively hold tens of thousands of patents that have been prosecuted in compliance with the Patent Act, 35 U.S.C. §§ 101 et seq., and have been involved in patent litigation as both plaintiffs and defendants. *Amici* are also frequent targets of infringement lawsuits based on patents of questionable validity, including patents containing ambiguously drafted claims. *Amici* have a strong interest in ensuring that the patent law is interpreted to serve its constitutional purpose of promoting the progress of science and useful arts, U.S. Const., art. I, § 8, cl. 8, and in particular, that claims be sufficiently definite so as to provide meaningful notice to other market participants.

Altera Corporation is a developer of programmable logic solutions, providing FPGAs, CPLDs and ASICs, along with design resources including development software, intellectual property cores and development kits, to more than 12,000 customers worldwide.

Cisco Systems, Inc. is a leader in designing, manufacturing and selling Internet Protocol-based networking and other products related to the

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1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the amici curiae, or their counsel, made a monetary contribution intended to fund its preparation or submission. The parties have been given appropriate notice and have consented to the filing of this brief. Such consents are being lodged herewith.

communications and IT sectors and provides services associated with their product. Cisco has over 8,000 issued United States patents.

The Computer & Communications Industry Association (CCIA) is an international, non-profit trade association of Internet, information technology, and communications companies, whose members employ more than 600,000 workers and generate annual revenues in excess of $200 billion. A list of CCIA members is available online at www.ccianet.org/members.

General Motors, LLC is part of the General Motors Company, one of the world's largest and most innovative automakers, with operations employing 205,000 people in every major region of the world and doing business in some 157 countries.

Google Inc. is an innovative technology company dedicated to the mission of organizing the world's information and making it accessible to millions of users around the world each day. Google develops and serves a broad range of internet services, including search, advertising, collaboration and mobile services.

Guidewire Software is a leading provider of enterprise software to the Property and Casualty Insurance industry.

Intuit Inc. is a leading provider of financial management, tax and online banking solutions for consumers, small and mid-sized businesses, accountants, and financial institutions.

Microsoft Corporation is one of the largest software companies in the world, providing innovative productivity solutions and other services to businesses and individuals.

SAP America, Inc. is a leading technology company focused on developing innovative software and computer-based business solutions.

ShoreTel is a leading provider of internet protocol (IP) unified communications solutions for businesses.

I. INTRODUCTION

Patent claims exist both to define and to put the public on notice of the scope of the patentee's property rights. To do this effectively, claims must be *definite*: they must allow a person of ordinary skill in the art to read and understand both what is claimed and what is not claimed. 35 U.S.C. § 112 ¶2.

The Federal Circuit's test for indefiniteness conflicts with this purpose. Under Federal Circuit law, a claim will not be invalidated as indefinite unless it has *no* discernible meaning. Claims that have multiple meanings are considered definite even where a person of ordinary skill in the art would not be able reliably to discern the claim's scope from among the possible alternatives. Thus, even where a person of ordinary skill in the art reasonably could interpret a claim in several different ways, and even where this ambiguity prevents the public from having notice of the claims' scope, the Federal Circuit will find the claim definite.

This approach is both legally wrong and bad policy. It is legally wrong because it is inconsistent with the approach set forth in this Court's precedents and enacted by Congress in the Patent Act. It is bad policy because it undermines the notice function of patent claims, promotes ambiguous claim drafting, and encourages frivolous litigation. For these reasons, and as set forth below, the

Court should grant *certiorari* and realign the governing law with the statutory objectives of the Patent Act.

II. ARGUMENT

A. The Definiteness Requirement Exists to Put the Public on Notice of What a Patent Covers

The purpose of a patent claim is to define the scope of the patentee's property rights. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) ("The claim 'define[s] the scope of a patent grant'"); *Altoona Publix Theaters v. Am. Tri-Ergon Corp.*, 294 U.S. 477 (1935) ("Under the statute, it is the claims of the patent which define the invention.").

The bounds of this definition need to be clear because the claim secures "all to which [the patentee] is entitled" while "apprising the public of what is still open to them." *McClain v. Ortmayer,* 141 U.S. 419, 424 (1891). As Justice Brandeis explained, "[t]he statute requires the patentee ... to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." *Permutit Co. v. Graver Co.*, 284 U.S. 52, 60 (1931); *see also General Elec. Corp. v. Wabash Appliance Corp.*, 304 U.S. 364, 368-69 (1938) ("The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public.").

The Federal Circuit has acknowledged that "the purpose of the definiteness requirement is to ensure that 'the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the scope of the patentee's right to exclude.'" *Hearing Components, Inc v. Shure Inc.*, 600 F.3d 1357 (Fed. Cir. 2010); *see also All Dental Produx, LLC v. Advantage Dental Prod. Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002) ("The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe.").

This public notice function is, however, frustrated where competitors cannot read claims and understand what they cover and what they do not. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) ("The statutory requirement of particularity and distinctness in claims is met only when the inventor clearly distinguishes what is claimed from what went before in the art and clearly circumscribes what is foreclosed from future enterprise."). A claim must not be so ambiguous that persons of ordinary skill in the art cannot reasonably be expected to understand its scope. Yet, as discussed further below, that is precisely the result of the Federal Circuit's test.

B. The Federal Circuit's "Insolubly Ambiguous" Test Frustrates the Goal of Providing the Public with Notice of What is Claimed

This Court has noted that, when it comes to patent law, a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). By structuring the law of indefiniteness so that claims are found valid even where they are susceptible to a wide variety of reasonable interpretations, the Federal Circuit has created just such a zone.

In particular, the Federal Circuit refuses to find indefiniteness "if the meaning of the claim is discernible, even though ... the conclusion may be one over which reasonable persons will disagree." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). As a result, "[o]nly claims 'not amenable to construction' or 'insolubly ambiguous' are indefinite" and claims are held definite if the terms "can be given *any* reasonable meaning." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (emphasis added); *see also Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004) ("if the claim is subject to construction, *i.e.*, it is not insolubly ambiguous, it is not invalid for indefiniteness.").

This standard is in direct conflict with the statutory requirement that a patent must set forth "claims particularly pointing out and distinctly claiming the subject matter" of the invention. 35 U.S.C. 112 ¶2. Even

claims that are not "particular" and "distinct" may nevertheless be given *some* reasonable meaning. To put it differently, the Federal Circuit has, by adopting the "insolubly ambiguous" standard, substantially departed from the underlying statutory language in a way that (as discussed further below) frustrates the underlying public policy.

For example, under this standard claims (including the one at issue in the present case) are held valid even when they are susceptible to *multiple* constructions, such that people of ordinary skill in the art cannot reasonably be expected to know which of the possible constructions is proper. So long as *some* reasonable meaning can be assigned by the court at the end of the day, the claim is held not indefinite, even where many such meanings of radically different claim scope are equally plausible.

As Judge Plager explained in dissenting from the Federal Circuit's decision to deny the defendant's rehearing petition in this case:

> the corollary derived from [the insolubly indefiniteness standard] is that if several persons of ordinary skill come up with competing but plausible interpretations of a disputed term . . . the problem is not one of an inherently ambiguous and potentially indefinite claim term, but rather the problem becomes simply one of picking the 'right' interpretation for that term. Since picking the 'right' interpretation—claim construction—is a matter of law over which this court rules, and since the view of the trial judge hearing the case is given little

> weight, . . . it is not until three court of appeals judges randomly selected for that purpose pick the 'right' interpretation that the public, not to mention the patentee and its competitors, know what the patent actually claims.

Pet. App. 76a-77a.

The Federal Circuit has tried to surmount this problem by adopting an approach premised on the idea that it is possible to decide between different plausible constructions by applying the available doctrines of claim construction in a principled manner. *See Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1348 (Fed. Cir. 2005) ("In the face of an allegation of indefiniteness, general principles of claim construction apply."); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) ("Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable..."). But this premise is not correct or supported by the data.

Indeed, the data shows that the Federal Circuit reverses challenged claim constructions on appeal nearly 40% of the time. Kimberly A. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 239 (2005). If it were really possible to reliably decide between equally plausible constructions through application of claim construction principles, the district courts (whose expertise in claim construction far exceeds that of most hypothetical scientific experts) would not be getting it wrong nearly half the time. It makes no sense to assert that virtually all claims are sufficiently definite to put the public on notice

of what is claimed, while the district courts' chance of correctly divining the scope of a patent's claims is little better than a coin flip.

For several reasons, the principles of claim construction often fail to provide meaningful guidance about which of several possible scopes a patent claim actually covers. First, courts can look to a very wide array of sources—both intrinsic and extrinsic—from which to derive a construction. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (sources that may be used in claim construction include claim language, the specification, prosecution history, general and technical dictionaries, treatises, expert testimony, and multiple canons of interpretation). And many of those interpretive sources, including dictionaries and expert testimony, are not readily available to those reading a patent to determine its scope. Indeed, in *Phillips*, the Federal Circuit acknowledged that "there is a virtually unbounded universe of potential extrinsic evidence ... that could be brought to bear on any claim construction question." *Id.* at 1318.

The problem is further compounded by the Federal Circuit's misapplication of the "clear and convincing evidence" standard to determinations of indefiniteness. *See, e.g., Halliburton Energy Serv. Inc. v. M-I, LLC*, 514 F.3d 1244, 1249-50 (Fed. Cir. 2008) (the insolubly ambiguous "standard is met where an accused infringer shows by clear and convincing evidence that a skilled artisan could not discern the boundaries of the claim based on the claim language, the specification, and the prosecution history, as well as her knowledge of the relevant art area."); *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010) (same);

Hearing Components Inc. v. Shure Inc., 600 F.3d 1357, 1366 (Fed. Cir. 2010) (same).

Leaving aside the question of whether or not questions of invalidity should generally be judged by the clear and convincing evidence standard,[2] the Federal Circuit's application of an evidentiary standard to questions of definiteness makes no sense. Indefiniteness is an issue of claim construction and therefore a pure issue of law. *See Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 705 (Fed. Cir. 1998) ("A determination of claim indefiniteness is a legal conclusion that is drawn from the court's performance of its duty as the construer of patent claims."); *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1377 (Fed. Cir. 1999) ("Indefiniteness, therefore, like claim construction, is a question of law that we review de novo."); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) ("Indefiniteness is a matter of claim construction, and ... a question of law"); *cf. Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc) (holding that claim construction is a question of law reviewed *de novo*).

An *evidentiary* standard, on the other hand, applies only to questions of fact. As the Federal Circuit described the distinction in *Newell Companies, Inc. v. Kenny Manufacturing Co.*, 864 F.2d 757, 767 (Fed. Cir. 1988), "[q]uantums of proof relate to proof of facts, not legal conclusions." *See also SSIH Equip., S.A. v. Int'l Trade*

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2. As explained by many of the amicus briefs filed in support of the Petition for Certiorari in *Microsoft Corporation v. i4i*, No. 10-290, there are substantial questions about whether the "clear and convincing" evidence standard is appropriate for questions of validity, and if it is appropriate, when. This brief does not address these questions.

Comm'n, 718 F.2d 365, 375 (Fed. Cir. 1983) ("we find it inappropriate to speak in terms of a particular standard of proof being necessary to reach a legal conclusion. Standard of proof relates to specific factual questions.").

The Federal Circuit has not only conflated legal and factual questions, but also has built in precisely the zone of uncertainty that this Court warned against in *United Carbon*. Indeed, it is precisely where persons of ordinary skill in the art could reasonably disagree about the scope of the claim (i.e. where there is a zone of uncertainty about what the claims cover) that there will be a "dispute of fact" about what the claims cover and thus where, under the Federal Circuit's approach, the claim must be held valid.

The practical result of the Federal Circuit's test and the mistaken application of an evidentiary standard is that claims are rarely held indefinite, even where there is no reasonable way for people reading the patent to know *which* construction is correct and hence to know what is and is not covered by the claims. Indeed, at least one recent study suggests that, over the ten years period between 1998 and 2008, during which time the Federal Circuit applied the "insolubly ambiguous" standard, the percent of district court cases finding challenged claims to be definite has increased by sixty percentage points (from approximately 24% to approximately 84%).[3] Thus, the available data strongly suggests that the Federal Circuit's approach to the question of indefiniteness is a substantial factor in the outcomes of a meaningful number of cases.

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3. Christa J. Laser, *A Definite Claim on Claim Indefiniteness: An Empirical Study of Definiteness Cases of the Past Decade with a Focus on the Federal Circuit and the Insolubly Ambiguous Standard*, 11 CHI.-KENT J. INTELL. PROP. 25 (2010).

C. The Federal Circuit's Test Is Inconsistent with the Patent and Trademark Office's Approach and the Approach of the Regional Circuits

As discussed previously, the Federal Circuit's approach to indefiniteness is at odds with the statutory requirement that a claim be sufficiently "distinct" and "particular" so as to provide notice of what is claimed and what is not claimed. It is, therefore, not surprising that the Federal Circuit's approach is also incompatible with the approach taken by other circuit courts and by the United States Patent & Trademark Office (PTO).

In contrast to the Federal Circuit, for example, the PTO's Board of Patent Appeals and Interferences (BPAI) has held (in a rare precedential opinion) that "rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claims unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite." *Ex Parte Miyazaki*, 89 U.S.P.Q.2d 1207 (BPAI 2008), at *5.

While the BPAI pointed to the applicant's ability to fix claims during prosecution to justify its use of a lower standard than the one employed by the Federal Circuit, it is not clear why that difference should matter in light of the purpose of the definiteness requirement. As noted previously, the primary purpose of the definiteness requirement is to avoid ambiguity by putting the public on notice of what is and is not claimed by the patent. Restricting post-issuance indefiniteness challenges to situations in which there is *no* reasonable construction

for a claim term does nothing to eliminate that ambiguity. And it puts the burden on the wrong party. Why should the public bear the cost of that uncertainty when the applicant is in the best position to avoid it through careful claim drafting in the first instance? Indeed, as Judge Plager noted in his dissent to the *en banc* petition below, the patent prosecution literature actively *encourages* applicants to draft their claims in a purposefully ambiguous manner in order to impose these costs on competitors. *Enzo Biochem, Inc. v. Applera Corp.*, 605 F.3d 1347, 1348 n.2 (Fed. Cir. 2010) (Plager, J., dissenting from denial of rehearing). *See also* Stephen M. McJohn, *Patents: Hiding From History*, 24 SANTA CLARA COMP. & HIGH TECH. L.J. 961, 971 (2008) ("experts in claim drafting offer the following advice to inventors and patent drafters: Do not define the terms used in your claims; do not identify the category of invention in the preamble to the claims; do not identify features of the invention as "important;" and do not even use the word "invention" in the written description. Such claim drafting has been described as a trend toward 'intentional obscurity.'"). There is little to discourage applicants from drafting ambiguous claims when there is no downside (because they know that the claims will be held valid so long as *some* meaning can be assigned), and where the ambiguity otherwise resounds to the patent holder's benefit (because it allows them to alter the scope of the claim as later circumstances warrant).

The Federal Circuit rule also has created a circuit split on the issue of the proper standard for indefiniteness. Before 1982, when regional circuits heard patent infringement suits, they applied a more stringent standard. For example, in *Norton Co. v. Bendix Corp.*, 449 F.2d 553 (2d Cir. 1971), the Second Circuit found invalid as

indefinite a patent on a vacuum pump in which the nozzle was claimed as being "*closely spaced*" in relation to the lip and in which the guard ring extended a "*substantial distance* beyond said lip into the jet of vapor, thereby to condense the undesirably over-divergent portion of the vapor jet as it emerges from under the nozzle." The Court found that the italicized terms were indefinite because they did not "clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise." To support this proposition the court noted that "there were several commercial compositions falling within the peripheral area of uncertainty" and found that this fact demonstrated that the claims "fail to inform the public as to what may or may not be manufactured." *Id.* at 557.

Under the Federal Circuit's current standards, as reflected in the decision below, *Norton* was incorrectly decided. After all, in the case below, the Federal Circuit found that the closely analogous phrase "not interfering substantially" was definite because there was "some standard for measuring that degree" insofar as "the claims in this case provide at least some guidance as to how much interference will be tolerated." Pet. App. 14a. The same thing was true in *Norton*, however, where the claims provided that the substantiality of the distance should be judged in terms of the resultant condensation of the vapor jet. The two cases are squarely and irreconcilably at odds with one another. *See also Antonious v. ProGroup, Inc.*, 699 F.2d 337, 340 (6th Cir. 1983) (finding indefinite a claim calling for a flexible fastener located on "the back portion of the glove extending from one edge of the opening to the other" despite the fact that the claim provided guidance on the purpose of the fastener and fact that the claim was

not insolubly ambiguous.) The Federal Circuit's "insolubly ambiguous" test heightens the standard the other regional Circuits used to judge indefiniteness and results in claims being upheld even where the ambiguity of those claims creates a substantial "zone of uncertainty" about the allowed scope of economic activity.

D. Patentees Take Advantage of the Federal Circuit's Lower Standard to Bring Meritless Claims

The law currently encourages applicants to draft ambiguous claims. Because the boundaries of these claims are indeterminate, patentees can and do file suit against products that are not within the proper scope of their patents. It has become common in recent years for plaintiffs to sue dozens of companies with vastly divergent products based on ambiguous patent claims covering inventions the plaintiffs never turned into products. There are literally hundreds of such cases filed each year.[4] Indeed, it is not uncommon for companies (including some of the *amici*) to have to defend against more than *thirty* patent litigations at any given time.

One problem that arises is that it is not uncommon for plaintiffs in these cases to seek to collect settlements of a few hundred thousand to a few million dollars from each of the defendants. Even where their patents are weak, they

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4. Recent empirical evidence suggests that 83.2% of the most-litigated patents – the ones that involve the most suits against the most defendants – are filed by such non-practicing entities targeting an entire industry. John R. Allison et al., *Patent Quality and Settlement Among Repeat Patent Litigants*, 99 GEO. L.J. __ (forthcoming 2011), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1677785.

frequently succeed in this enterprise because the scope of the asserted patent's claims is unclear and so the cases are not subject to early summary judgment motions. Instead, defendants must choose between spending a great deal of money to litigate the case through claim construction before they can bring dispositive motions[5] or settling with the defendants. Not surprisingly, most settle, even when the underlying cases are weak.[6] This creates a substantial cost for businesses which, like some of the undersigned *amici*, may have dozens of patent lawsuits pending against them at any one time.[7] And, while the litigation-cost hold up problem in patent cases is not solely attributable to the Federal Circuit's indefiniteness standard, the undersigned *amici* strongly believe it is a substantial contributing factor because it encourages ambiguous claim drafting.

Even where the plaintiffs are not simply using transaction costs to extract settlements, ambiguous patents can result in meritless litigation. Some plaintiffs, for example, assert ambiguous patents against large companies in the hopes of winning a sizable judgment.

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5. A recent survey of intellectual property firms reports that the average cost in legal fees to take a large patent case to trial is $5.5 million per side. AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, REPORT OF THE ECONOMIC SURVEY 22 (2009).

6. Allison et al., *supra*, find that 89.6% of all non-practicing entity suits settle, despite the fact that when such cases go to judgment, the non-practicing patentee wins only 8% of the time.

7. *See* JAMES BESSEN & MICHAEL J. MEURER, PATENT FAILURE: HOW JUDGES, BUREAUCRATS AND LAWYERS PUT INNOVATORS AT RISK 127 (2008) ("We thus conclude that patent litigation is a real problem for innovators and it does impose a cost on investment in innovation.")

These enormous judgments, while uncommon, have an outsized impact. Where claims are ambiguous enough that no one can tell in advance what such a claim covers, the resulting uncertainty can be debilitating for companies that must decide whether to litigate or license the patent.

The proliferation of ambiguous patent claims also increases the time, cost and expense of reviewing patents and of working around them. This is highly undesirable from the perspective of public policy. Companies should be encouraged and rewarded for their efforts to read patents, both because that behavior increases the dissemination of the information contained in the patent specification and because, insofar as companies can understand and work around the inventions claimed in the patents they review, it reduces litigation.

Problems associated with ambiguous patent claims are compounded by the dramatic increase in the number of patents over time. From 1963 to 2009, for example, the number of utility patents granted per year expanded from fewer than 46,000 to more than 167,000 – a nearly fourfold increase.[8] And because the effect is cumulative, the number of *outstanding* patents has grown even more dramatically – indeed, approximately one and a half times as many patents have been issued *since* 1996 than were issued in *all years prior* to 1996.[9] Unless patents provide robust notice of what they cover and what they do not cover, the ever-increasing number of outstanding patents

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8. http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm.

9. http://www.uspto.gov/web/offices/ac/ido/oeip/taf/apat.htm#PartA1_1.

of ambiguous scope will impose larger and larger costs on innovative companies. This problem is especially severe in the fastest growing areas of the economy, where the high density of patents makes it critical to have well-defined claims with discernible boundaries.

E. The Proper Approach Would Give Reasonable Notice of Claims' Meaning

Amici respectfully suggest that the proper standard for judging definiteness should be drawn directly from the purpose of that requirement. In particular, a claim should be held invalid as indefinite if a person of ordinary skill in the art would not know, in advance and with reasonable particularity, what the claim covers and what it does not cover. To put it differently, if a reasonable person of ordinary skill in the art could not be expected to know the metes and bounds of the claim, the claim is not sufficiently definite to provide adequate public notice.

By adopting a standard based on the notice function of the definiteness requirement, the Court would breathe life into the idea that patent claims should provide reasonable notice of what they cover.

F. This Court Should Take This Case to Revitalize the Law of Indefiniteness

The Federal Circuit continues to use a standard for evaluating indefiniteness that conflicts with this Court's precedents, even where, as in this case, the issue was squarely presented in an *en banc* petition and where a respected senior Federal Circuit judge urged the court to reconsider. If this Court does not act, there will be little

or no incentive for future litigants to raise the issue in the lower courts. Moreover, this is not a case where the Federal Circuit's law differs from the law of this Court by a matter of degree or in ways that are unlikely to matter. Instead, as discussed above, the Federal Circuit's law in this area directly subverts the purpose of the definiteness requirement, contravenes the principles established by this Court, mistakes an issue of law for an issue of fact, and conflicts with the approaches taken by both the Patent and Trademark Office and the other regional Circuit courts.

III. CONCLUSION

The petition for certiorari should be granted.

Respectfully Submitted,

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